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ATTORNEYS AT LAW

Docket No.: 219028US0CONT

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/083,387

Applicants: Hideaki SAKAI, et al.

Filing Date: February 27, 2002

For: PROCESS FOR PRODUCING FRIED INSTANT  
NOODLES

Group Art Unit: 1761

Examiner: TRAN, Lien T.

SIR:

Attached hereto for filing are the following papers:

**Complete New APPEAL BRIEF Under 37 CFR 1.192(c) (In Triplicate)**

Our check in the amount of \$-0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Richard L. Chinn, Ph.D.

Registration No. 34,305

Customer Number

**22850**

(703) 413-3000 (phone)  
(703) 413-2220 (fax)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: :

Hideaki SAKAI, et al. : GROUP ART UNIT: 1761

SERIAL NO.: 10/083,387 : EXAMINER: TRAN, Lien T.

FILED: FEBRUARY 27, 2002 :

FOR: PROCESS FOR PRODUCING :  
FRIED INSTANT NOODLES

APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

The following is an appeal of the examiner's final rejection of January 30, 2004 of claims 1-7, 11-14, 16-20 and 22-23 as obvious over Greene et al. in view of Gotoh et al. and of claims 8-10 and 15 as obvious over Greene et al. in view of Gotoh et al. and in further view of Miyazaki et al. A notice of appeal was timely filed on February 9, 2004. In response to the Notification of Non-compliance issued June 10, 2004, Appellants submit herewith a new brief in compliance with 37 C.F.R. § 1.192(c).

REAL PARTY IN INTEREST

The real party in interest is the Kao Corporation, of Tokyo, Japan, by assignment filed at reel/frame 012861/0730-0732.

RELATED APPEALS AND INTERFERENCES

Appellants, appellants' legal representative and the assignee are not aware of any related appeals and interferences which will directly affect or be directly affected, or have a bearing on the Board's decision in the pending appeal.

#### STATUS OF CLAIMS

Claims 1, 3-20 and 22 remain active in this application and are herein appealed.

#### STATUS OF AMENDMENTS

Three amendments have been submitted and entered. A first amendment was submitted and entered on December 30, 2002 amending claim 1 and adding claims 21 and 22. A second amendment was submitted on July 14, 2003, amending claim 18, canceling claim 21 and adding claim 23. A third amendment was submitted on January 8, 2004, amending claims 1 and 19, canceling claims 2 and 23. The advisory action of January 30, 2004 indicates that appellants' amendment would be entered. A copy of the claims herein appealed is attached as an appendix.

#### SUMMARY OF THE INVENTION

The present invention is directed to a method of producing friend instant noodles, and fried instant noodles obtained by such a method (page 2, lines 14-16 and page 4, line 18 of the specification).

Fried instant noodles are generally produced by mixing and kneading raw materials into a dough, forming dough into noodle strips, steam-heating noodles to gelatinize starch in the noodle strips and then frying the steam-heated noodle strips (page 1, lines 8-11 of the specification). In the frying step, the gelatinized noodle strips are quickly dehydrated, providing the dried noodles with a quick reconstitutability (page 1, lines 11-13 of the

specification). Problems heretofore observed with fried instant noodles have been poor surface smoothness and a tendency to rapidly become soggy such that noodle-producing processes in which the properties of noodle surface smoothness and the tendency to get soggy are improved are sought.

The present invention addresses this problem by providing a method for producing fried instant noodles comprising heating noodles in an oil/fat composition comprising at least 60 weight % of diglycerides, thereby producing fried instant noodles, which upon reconstitution with water have a smooth structure. Such a method of fried instant noodles are nowhere disclosed or suggested in the cited prior art of record.

### ISSUES

1. Whether claims 1-7, 11-14, 16-20, 22 and 23 are not patentable as obvious under 35 U.S.C. § 103(a) over Greene et al. in view of Gotoh et al.
2. Whether claims 8-10 and 15 are not patentable under 35 U.S.C. § 103(a) over Greene et al. in view of Gotoh et al. and in further view of Miyazaki et al.

### GROUPING OF CLAIMS

With respect to the issue as identified above, for the limited purposes of this appeal, the claims do not stand and fall together;

For the purposes of issues 1 and 2 the claims are grouped as follows:

Group I, claims 1, 5-20 and 22;

Group II, claim 3; and

Group III, claim 4.

### ARGUMENTS

The claims are not rendered obvious because none of the cited prior art of record suggests an improved texture resulting from preparing instant fried noodles using an oil/fat composition comprising at least 60 wt. % of diglycerides. The examiner has committed reversible error in concluding the claimed invention to be obvious over the cited prior art, as none of the cited prior art of record suggests an improved texture resulting from preparing instant fried noodles using an oil/fat composition comprising at least 60 wt. % of diglycerides.

Gotoh et al. describes a liquid general-purpose edible oil containing 1,3-diglycerides, in an amount of at least 40% by weight and a most preferable amount of at least 50% by weight (column 2, lines 44-49). There is no disclosure or suggestion of the preparation of instant fried noodles. As a general-purpose oil which is described as having beneficial health effects as well as excellent storage stability and flavor (column 2, lines 37-44), there is no suggestion of an improved texture of an instant-fried noodle. Moreover, as Gotoh et al does not prepare fried instant noodles, there can be no expectation of obtaining fried instant noodles having an improved texture. The claimed method is nowhere disclosed or suggested in Gotoh et al.

The examiner relies on Greene et al. for teaching a general method of preparing instant fried noodles, in the absence of a teaching of the claimed diglyceride oil composition. Appellants have not completely reinvented a method of making instant fried noodles (see page 1, lines 8-13 of appellant's specification). Appellants have discovered by frying gelatinized noodle strips in an oil/fat composition comprising at least 60 wt.% of diglycerides, that the texture of the noodle upon reconstitution is improved. By failing to disclose or suggest an oil composition comprising at least 60 weight% of diglycerides, the reference cannot suggest that in a method for the preparation of fried instant noodles, an improved texture would be obtained.

Miyazaki et al. has also been cited by the examiner as disclosing a method of making fried instant noodles in which additives such as an antioxidant and egg are added (column 5, lines 1-5). Miyazaki et al. fails to disclose or suggest a method of heating noodles in an oil/fat composition comprising at least 60 wt.% of diglycerides. Like Greene et al., by failing to disclose or suggest an oil composition comprising at least 60 weight% of diglycerides, the reference cannot suggest that in a method for the preparation of fried instant noodles, an improved texture would be obtained.

Appellants have discovered that use of an oil composition comprising at least 60% of diglycerides in a frying step of a method of producing fried instant noodles, provides for an improvement in the texture of reconstituted fried instant noodles, a result which is not suggested in the cited references.

As evidence of the production of fried instant noodles having a smooth structure, appellants submitted the declaration of Kohori Jun, a researcher in the field of biotechnology and food science, employed by the Kao Corporation, the assignee of the above-identified application.

The production process was as follows, which is as close to the method disclosed in Greene et al. as possible, utilizing oils that fall within that disclosed by Gotoh et al. and oils to produce fried instant noodles. Again, Appellants have not completely reinvented a method of making instant fried noodles. Appellants have discovered, that in an otherwise known method of making instant fried noodles, by frying in an oil/fat composition comprising at least 60 wt.% of diglycerides, that the texture of the reconstituted noodle is improved. Accordingly, the issues as to the specifics of the tests, raised by the examiner in the advisory action of January 30, 2004 are largely irrelevant, as the issue is not whether the fried instant noodles of Greene et al. anticipate the claimed invention, but rather would a method of preparing fried instant noodles using an oil/fat composition comprising at least 60 wt.% of

diglycerides, have been obvious. For this reason an **exact** reproduction of the method of Greene et al. is simply not required. Appellants' direct head-to-head comparison, changing only the composition of the oil used to fry the noodles is probative of the lack of obviousness of the claimed invention.

The formulations of the oils are shown in Table 1

Table 1

| Sample | preparation                |  |               |                         |                            | a content (wt%) of |               |                 |
|--------|----------------------------|--|---------------|-------------------------|----------------------------|--------------------|---------------|-----------------|
|        | Rapeseed Oil <sup>1)</sup> | Hi Di-glycerides oil/fat <sup>2)</sup> | Vitamin E (%) | Ascorbic Acid ester (%) | Silicone <sup>3)</sup> (%) | Tri-glycerides     | Di-Glycerides | Mono-glycerides |
| (1)    | 0.00                       | 99.90                                  | 0.07          | 0.03                    | 0.0002                     | 13.5               | 85.7          | 0.7             |
| (2)    | 24.98                      | 74.93                                  | 0.07          | 0.03                    | 0.0002                     | 34.7               | 64.7          | 0.5             |
| (3)    | 49.95                      | 49.95                                  | 0.07          | 0.03                    | 0.0002                     | 55.9               | 43.7          | 0.3             |
| (4)    | 99.90                      | 0.00                                   | 0.07          | 0.03                    | 0.0002                     | 98.3               | 1.6           | 0.0             |

1) "Canola Oil", a product of Honen Corp.  
 2) Tri-glycerides 13.5%, Di-glycerides 85.8%, Mono-glycerides 0.7% (Oil/Fat obtained by reacting fatty acid, which had been obtained by hydrolyzing refined rapeseed oil, with glycerin in a manner known per se in the art while using an immobilized, 1,3-specific lipase as a catalyst and then refining the reaction product  
 3)"K S - 6 6", a product of Shin-Etsu Chemical Co., Ltd.

Oil samples (1) and (2) have a diglyceride content of at least 60 wt.%, while samples (3) and (4) have a diglyceride content below 60 wt.% and are therefore outside the scope of the claims and are therefore viewed as comparative examples.

Noodles were produced by optimizing the general method of Greene.

The results of the classification of the noodles follows in Table 2.

Table 2

|   | Flavor   |       |        | Texture     |            |            |
|---|----------|-------|--------|-------------|------------|------------|
|   | Oiliness | Flour | Kansui | Smooth-ness | Elasticity | Soggi-ness |
| 1 | A        | A     | A      | A           | A          | A          |
| 2 | A        | B     | B      | B           | B          | A          |
| 3 | A        | B     | B      | C           | C          | A          |
| 4 | A        | C     | C      | D           | C          | A          |

The results of Table 2 demonstrate that the noodle that has been produced using sample (1) or sample (2) in which the diglyceride content of at least 60 wt.%, as frying oils have superior smoothness and elasticity, as compared with the otherwise same method utilizing sample (3) and sample (4), having a diglyceride content below 60 wt.%, as frying oils. Thus, the noodles made from the claimed method in which the diglyceride content is at least 60 wt.% are clearly superior in elasticity and smoothness when compared to noodles made using a oil/fat composition containing less than 60 wt.% of diglyceride.

In light of the above, it is clear that a noodle heated in an oil containing less than 60% and greater than 40% diglyceride as disclosed by Gotoh et al. and further prepared according to an optimized method disclosed by Greene et al. is less acceptable in regards to its smoothness and elasticity.

In contrast, the claimed noodle made by the claimed method of heating in an oil containing at least 60% is superior in regards to its smoothness and elasticity compared to those noodles heated in an oil disclosed by Gotoh et al.

The examiner had committed reversible error, in failing to consider appellants' objective evidence of nonobviousness.

Rebuttal evidence and arguments can be presented by way of an affidavit or declaration under 37 CFR 1.132, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687; *In re Piasecki*, 745 F.2d 1468, 1474, 223 USPQ 785, 789-90 (Fed. Cir. 1984).

Appellants have provided rebuttal evidence that the claimed invention yields a fried instant noodle with unexpectedly improved texture upon reconstitution.

Rebuttal evidence may also include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art. Rebuttal evidence may consist of a showing that the claimed compound possesses unexpected properties. *Dillon*, 919 F.2d at 692-93, 16 USPQ2d at 1901.

The examiner, in the advisory action of January 30, 2004, is also critical of the test data presented in the Jun declaration in terms of the specific details of how the testing was

conducted, such as the number to samples, who evaluated, possible variations in detecting the flavor of flour, and how the differences in smoothness, elasticity and sogginess were measured. The testing parameters are provided in pages 4 and 5 of the Jun declaration. The declaration also states, on page 6, that the results demonstrate a superior smoothness and elasticity for samples (1) and (2) as compared with samples (3) and (4). Thus the probative value of the data from the declaration is clear.

The examiner also criticized the Jun declaration because it is not clear to her whether the noodle tested is the same type as claimed. In so far as the examiner has cited the reference of Greene et al. as describing a method of preparing fried instant noodles and based her rejection for obviousness on the method described in this reference, and appellants have closely followed the method described in Greene et al. the correlation between the test results and the claimed invention is very clear.

The examiner has erroneously dismissed appellants' demonstration of an unexpected improvement in reconstituted noodle texture and therefore the decision of the primary examiner must be reversed.

Group II:

This embodiment is directed to a method in which the diglyceride content of the fat/oil is 65 wt.%.

While appellants have clearly provided evidence of an improved texture for reconstituted noodles when prepared with an oil/fat comprising at least 60 wt.% of diglycerides, sample (1) in which the diglyceride content was 85.7% was judged even better in term of smoothness and elasticity, than even sample (2) and far better than samples (3) and (4). Therefore, appellants' demonstration of improved performance further supports the separate patentability of the claimed subject matter of claim 3 which recites a diglyceride

content of 65 wt.% or more. The decision of the primary examiner as to claim 3 must be reversed.

Group III:

This embodiment is directed to a method in which the diglyceride content of the fat/oil is 70 wt.%.

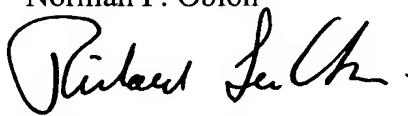
While appellants have clearly provided evidence of an improved texture for reconstituted noodles when prepared with an oil/fat comprising at least 60 wt.% of diglycerides, sample (1) in which the diglyceride content was 85.7% was judged even better in term of smoothness and elasticity, than even sample (2) and far better than samples (3) and (4). Therefore, appellants' demonstration of improved performance further supports the claimed subject matter of claim 4 which recites a diglyceride content of 70 wt.% or more.

The decision of the primary examiner as to claim 4 must be reversed.

Appellants submit that the decision of the primary examiner is in error and therefore must be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon



Richard L. Chinn, Ph.D.  
Attorney of Record  
Registration No. 34,305

Customer Number

**22850**

Tel. (703) 413-3000  
Fax. (703) 413-2220

RLC:dbl

Appendix

1. A method for producing fried instant noodles, comprising heating noodles in an oil/fat composition comprising at least 60 wt.% of diglycerides, wherein upon reconstitution of said fried instant noodles with water, said noodles have a smooth structure.
3. The method of claim 1, wherein said oil/fat composition comprises at least 65 wt.% of diglycerides.
4. The method of claim 1, wherein said oil/fat composition comprises at least 70 wt.% of diglycerides.
5. The method of claim 1, wherein said diglyceride contains acyl groups having 8 to 24 carbon atoms.
6. The method of claim 1, wherein said diglyceride contains acyl groups having 16 to 22 carbon atoms.
7. The method of claim 1, wherein said diglyceride contains at least 70 unsaturated acyl groups of the whole constituent acyl groups.
8. The method of claim 1, wherein said noodle comprises 0.001 to 1 % by weight of an antioxidant.
9. The method of claim 8, wherein said antioxidant is selected from the group consisting of vitamin E, ascorbic acid, a higher fatty acid ester of ascorbic acid, catechin, rosemary and a mixture thereof.
10. The method of claim 8, wherein said antioxidant is ascorbic palmitate.
11. The method of claim 1, wherein said oil/fat composition is at a temperature of from 120 to 160 °C.
12. The method of claim 1, wherein said oil/fat composition is at a temperature of from 130 to 150 °C.

13. The method of claim 1, wherein heating is conducted for a time of from 0.3 to 5 minutes.

14. The method of claim 1, wherein heating is conducted for a time of from 0.5 to 3 minutes.

15. The method of claim 1, wherein said noodles are comprised of flour, a noodle quality improver, a thickening polysaccharide and egg powder.

16. The method of claim 1, wherein said noodles are prepared by the steps comprising:

- i) preparing a dough from raw materials;
- ii) laminating said dough;
- iii) rolling said dough;
- iv) sheeting said dough;
- v) slitting said dough to form noodle strands;
- vi) steam heating said noodle strands of step v); and
- vii) molding steam heated noodles of step vi).

17. The method of claim 15, wherein said flour is selected from the group consisting of wheat flour, buckwheat flour and a mixture thereof.

18. The method of claim 1, wherein said fried instant noodles comprise at least one composition selected from the group consisting of *udon* noodles, *soba* noodles, *ramen* noodles and pasta.

19. A method of preparing instant noodles comprising:

- i) heating noodles in an oil/fat composition comprising at least 60 wt.% of diglycerides to form fried instant noodles; and
- ii) reconstituting said fried instant noodles with water.

20. Fried instant noodles obtained by the process of claim 1.

22. The method of claim 1, wherein said heating results in dehydration of said noodles.